IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of Fitzpatrick et al.   Art Unit 3622
Serial No. 09/840,648
Filed 04/23/2001
Confirmation No. 5040
For METHOD AND SYSTEM FOR ELECTRONICALLY SELECTING, MODIFYING, AND
OPERATING A MOTIVATION OR RECOGNITION PROGRAM
Examiner John W. Van Bramer

March 13, 2008

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

TO THE COMMISSIONER FOR PATENTS,

SIR:

In response to the Notification of Non-Compliant Appeal Brief, dated February 14, 2008, please replace the Grounds of Rejection to be Reviewed on Appeal, which begin at page 10 of the Appeal Brief, and please replace the Argument, which begins at page 10 of the Appeal Brief, with the following:

Amended Grounds of Rejection to be Reviewed on Appeal, which begin on page 2 of this paper; and

Amended Argument, which begins on page 3 of this paper.

Remarks begin on page 14 of this paper.

AMENDED GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Appellant appeals the rejections of claims 1, 3-7, 15, 24, 52, 53, 55, 56 and 61 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent Number 6,061,660 (Eggleston). Appellant further appeals the rejection of claim 2 under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. (U.S. Patent Number: 6,061,660) in view of Hoffman and Rogelberg "A guide to team incentive systems," Team Performance Management, vol. 4 no. 1, pp. 23, 1998 (Hoffman and Rogelberg) and the rejection of claim 39 under 35 U.S.C. 103(a) as being unpatentable over Eggleston et al. in view of Symons and Jacobs "A Total Quality Management-Based Incentive System Supporting Total Quality Management Implementation", Production and Operations Management, Vol. 4, No. 3, Summer 1995 (Symons and Jacobs).

AMENDED ARGUMENT

Rejection under 35 U.S.C. §102(e) over U.S. Patent Number 6,061,660

A claim is anticipated only if each and every element as set forth in the claim is disclosed, either expressly or inherently in a single prior art reference.[1] Appellant submit that each and every element as set forth in the recited claims is not found, either expressly or inherently in the Eggleston reference. In particular, Eggleston *only* illustrates that each customer can download and operate their modified program via their processor and fails to disclose multiple programs by various sponsors on the same host, as recited by claims 1 and 24. In addition, Eggleston *only* illustrates the modification of eligibility rules and fails to disclose a selectable rules structure in combination with multiple programs on the same storage device and executed by the same program processor, as recited by claims 55 and 61.

Thus, the Eggleston reference does not anticipate the claims.

A. Summary of Eggleston

Eggleston teaches a method for providing incentive programs over a computer network. In particular, the incentive program is downloaded or transmitted to the sponsor for installation and operation at the sponsor's own site after the incentive program is purchased. (Eggleston, FIG. 10, reference character 368; FIG. 11, reference character 388; column 14, lines 50-53; column 19, lines 14-19; and column 19, lines 44-48). For example, Eggleston discloses "[w]hether the sponsor purchases a pre-packaged incentive program or chooses to build an incentive program, the completed incentive program is downloaded to the sponsor for installation on a web site of the sponsor." (Eggleston, column 14, lines 50-53). Eggleston teaches that once the incentive program has been downloaded and installed on the sponsor's own site, the sponsor provides a link to the host. (Eggleston, column 19, lines 20-21 and 49-50; column 30, lines 6-9). For example, at column 14, lines 53-56, Eggleston teaches "[t]he sponsor database is updated to reflect the presence of the new incentive program, and the sponsor site 194 is updated to include a link to the new incentive program." Next, the host system updates the consumer directory of the consumer site to link to the incentive program installed on the sponsor's own site. (Eggleston, column 15, line 66 - column 16, line 2; column 19, lines 49-52;

---

[1] M.P.E.P. § 2131. *See also Schering Corp. v. Geneva Pharmaceuticals*, 339 F.3d 1373, 1379 (Fed. Cir. 2003) (citing *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987)).

column 26, lines 62-65) For example, Eggleston discloses "the host computer updates the consumer home page of the consumer site to reflect the presence of a new incentive program and a link to the new incentive program." (Eggleston, column 19, lines 26-29) In other words, Eggleston teaches that a sponsor (1) purchases incentive programs from the sponsor site of the host, (2) downloads the purchased program to the sponsor's own server, and (3) provides a link to the host, as a result, the consumer can access the incentive program on the sponsor's own web server from a HTML link in the consumer directory of the consumer site of the host.

B. Claims 1 and 24

Claim 1 is directed to a method for a first customer and a second customer to create individual modified motivation or recognitions programs where each customer's participants access their modified program stored in the same storage device connected to the program processor and where the accessed programs are executed by the same program processor, and not executing by the individual customer processors. Claim 24 is directed to a system for allowing multiple customers to create individual modified motivation or recognitions programs where each customer's participants access the modified program stored in the same storage device connected to the program processor and executed by the same program processor, and not executing by the individual customer processors.

Appellant submits that claims 1 and 24 are unanticipated by and patentable over Eggleston in that Eggleston fails to disclose or teach:

> **allowing the first customer to operate the modified first program via the program processor, and allowing the second customer to operate the modified second program via the program processor, wherein the first and second participant processors and the first and second customer processors are remote from said program processor and remote from the storage device connected to the program processor**; and
> **providing the first customer's participants with access via the first participant processors to the modified first program stored in the storage device, and providing the second customer's participants with access via the second participant processors to the modified second program stored in the storage device, said modified first and second programs executed by the program processor.**
> (Appendix, claim 1 at lines 34-43).

> **a storage device; and**
> **a program processor ...operative ...:**

4

> **to electronically provide to each customer access to a browsable
> catalog of predefined programs stored in the storage device, each program
> associated with a business challenge; ...**
>
> > **to allow each customer to electronically select one of the presented
> > predefined programs stored in the storage device;**
> >
> > **to allow each customer to modify at least one component of the
> > selected predefined program;**
> >
> > **to allow each customer to electronically store the modified program in
> > the storage device for access by such customer; ...**
> >
> > **said modified program executed by the program processor.**

(Appendix, claim 24 at lines 81-101).

One advantage to the recited method and system over Eggleston is that the administrator of the program processor is able to manage all programs of all customers via access to the program processor. In contrast, in Eggleston, the administrator would be required to access each customer processor to manage all programs of all customers. Thus, in the event that the administrator wants to make a change to all programs, according to the recited invention, the change could be made by accessing the program processor instead of accessing each customer processor.

1. Contrary to Examiner's Arguments, Eggleston fails to disclose multiple programs by various sponsors on the same host.

In the Response to Arguments on page 20 of the final Office action, the Examiner asserts that column 5, lines 46-55; column 10, lines 1-54; column 12, lines 39-48; column 14, lines 6-65; column 17, lines 25-50; and column 32, lines 53-64 of Eggleston teach the incentive program of various sponsors are stored and executed on the host machine. The Examiner also asserts that column 6, lines 13-19; column 6, lines 31-46; column 6, line 53 through column 7 line 6; and column7, line 54 through column 8, line 20; and column 12, lines 38-48 of Eggleston disclose additional support and definitions that would allow one of ordinary skill to determine that the remote host is able to operate the incentive program selected by the sponsor.

First, column 14, lines 6-65 teaches away from the Examiner's assertion by suggesting purchasing and downloading of the program. For example, column 14, lines 50-53 indicates that the host does not operate/execute the incentive program by disclosing "whether the sponsor purchases a pre-packaged incentive program or chooses to build an incentive program, the completed incentive program is **downloaded** to the sponsor for installation on a web site of the

5

sponsor" and that "the sponsor site is updated to include a link to the new incentive program." (Emphasis added). And, column 14, lines 5-19 generally disclose a sponsor registering at the sponsor site of the host. Column 14, lines 20-25 generally disclose that a registered sponsor may provide links (e.g., a URL) to a pre-existing incentive program sites or purchase incentive programs from the host. Lastly, column 14, lines 25-50 generally describe the process of purchasing an incentive program from the host.

Second, the other references in Eggleston cited by the Examiner are silent as where the operating/executing of the programs occurs. For example, column 5, lines 46-55 teach that the present invention "permits sponsors to build, buy, store, modify, offer, track and administer incentive programs", but not operating or executing the incentive program on the host machine. The Examiner is using hindsight garnered from the claims to read into Eggleston that multiple programs of multiple customers can be executed on the same host machine. Similarly, column 10, lines 1-54 teach a general client server model of distributed computing over the internet. Column 12, lines 39-48 describes a consumer site which provides a directory of links to incentive programs provided by the host system or provided by a third party, but fails to address where the "provided" incentive programs are executed or operated. Column 17, lines 25-50 discloses a method for a sponsor to log into the sponsor site of the host. And, column 32, lines 53-64 standalone software may be used to create the incentive program and the code may be stored in a database. But, the cited reference fails to disclose how or where the code is executed or operated, only stored.

Third, the references in Eggleston which the Examiner cites do not provide additional support that would allow one of ordinary skill to determine that the remote host is able to operate the incentive program selected by the sponsor. Again, the references are silent with respect to operation/execution of the incentive program. For example, column 6, lines 13-19 teaches that sponsor may list incentive programs on an internet site, obtain incentive programs from the host, build incentive programs using software of the host, associated prizes with incentive programs offered through the listing of the site, and the sponsor may fulfill awards won by consumers. Column 6, lines 31-46 generally discloses that consumers may participate in incentive programs from a plurality of sponsors. Column 6, line 53 through Column 7, line 6 generally discloses the process for generating an incentive program, but not operation or execution of the incentive

program. And, column 7, line 54 through column 8, line 20 generally defines the terms host and sponsor, but does not address the operation or execution of an incentive program.

2. Eggleston _only_ illustrates that each customer can download and operate their modified program via their processor.

Eggleston teaches in detail five (5) embodiments where the program is downloaded or mailed to the sponsor for installation at the sponsor's site and does not disclose a single embodiment where the program is operated on the host computer. (See, (1) Fig. 10; Column 14, lines 50-65; (2) Fig. 10; Column 19, lines 14-17; (3) Fig. 10; Column 19, lines 18-19; (4) Column 29 line 67 - Column 30 line 9; and (5) Fig. 11; Column 32, lines 37-41.)

Notably, Eggleston does not teach or disclose any embodiments where the incentive program purchased by a sponsor is installed or executed on the sponsor site of the host system or elsewhere on the host system. In contrast, Eggleston repeatedly teaches that a purchased incentive program is downloaded to the sponsor's own site and not the sponsor site located on the host system. When read in the light of the specification, Eggleston teaches that a sponsor (1) purchases incentive programs from the sponsor site of the host, (2) downloads the purchased program to the sponsor's own server, and (3) provides a link to the host so that the consumer can access the incentive program on the sponsor's own web server from a HTML link in the consumer directory of the consumer site of the host.

For example, at column 14, lines 50-53, Eggleston teaches "[w]hether the sponsor purchases a pre-packaged incentive program or chooses to build an incentive program, the completed incentive program is **downloaded** to the sponsor for installation on a web site of the sponsor." And, at column 19, lines 14-17, Eggleston teaches "at a step 368 the pre-packaged incentive program is transmitted to the sponsor by electronic mail or other file transfer protocol, so that the sponsor can **download** the incentive program on the sponsor's own server." And, at column 19, lines 17-19, Eggleston teaches "the code could be mailed on a disk with instructions for **downloading** into the sponsor's own site." (Also see FIG. 10.) At column 19, lines 44-48, Eggleston teaches "in a step 388 the incentive program that was built is transmitted to the sponsor by conventional means such as electronic mail, disk or file transfer, so that the sponsor can **install** the new incentive program **on the sponsor's server** for the sponsor's own site. (Also see FIG. 11.) Further, at column 29, line 67 to column 30, line 3, Eggleston discloses "[o]nce

payment is confirmed, an application program sends a file containing the incentive program by electronic mail to the sponsor, who can then **download** the incentive program at the sponsor's site." Lastly, at column 32, lines 37- 41, Eggleston discloses "[o]nce payment is confirmed, an application program sends a file containing the incentive program by electronic mail to the sponsor, who can then **download** the incentive program at the sponsor's site." (Emphasis added.)

Eggleston consistent with the above then teaches that, after the incentive program has been downloaded and installed on the sponsor's own site, the sponsor provides a link to the host. (Eggleston, column 19, lines 20-21 and 49-50; column 30, lines 6-9). For example, at column 14, lines 53-56, Eggleston teaches "[t]he sponsor database is updated to reflect the presence of the new incentive program, and the sponsor site 194 is updated to include a link to the new incentive program."

Next, the host system updates the consumer directory of the consumer site to link to the incentive program installed on the sponsor's own site. (Eggleston, column 15, line 66 - column 16, line 2; column 19, lines 49-52; column 26, lines 62-65). For example, Eggleston discloses "the host computer updates the consumer home page of the consumer site to reflect the presence of a new incentive program and a link to the new incentive program." (Eggleston, column 19, lines 26-29).

In contrast, independent claims 1 and 24 recite the combination of multiple programs by various sponsors on the same host system.

Claim 1

Claim 1 recites:

> A method for allowing a first customer to create an individual, modified motivation or recognition first program having first participants..., said method for allowing a second customer to create an individual, modified motivation or recognition second program having second participants ..., said method comprising the steps of:
> …
> allowing the first customer to operate the modified first program via the program processor, and allowing the second customer to operate the modified second program via the program processor, wherein the first and second participant processors and the first and second customer processors are remote from said program processor and remote from the storage device connected to the program processor; and
> providing the first customer's participants with access via the first participant processors to the modified first program stored in the storage device, and providing the second customer's participants with access via the second participant processors to the

modified second program stored in the storage device, **said modified first and second programs executed by the program processor**. (Appendix, lines 1-13 and 34-43, Emphasis added.)

None of the references in Eggleston, taken individually or in combination, discloses or suggests the combination of these elements so that the modified programs of different customers are executed by the same program processor. Without teaching this combination of elements, Eggleston cannot anticipate claim 1.

The present invention allows a first and second customer "to operate the modified program via the program processor, and wherein the participant processor and the customer processor are remote from said program processor and remote from the storage device," as recited in claim 1 and shown in FIG. 1 and 10. (Also see, specification page 12, lines 12-13; FIG. 10, page 29, line 21- page 31, line 14). Furthermore, the operating software used to operate the program remains local to the program processor. For example, the first and second customers are allowed to "personalize follow-up promotions 1010 and schedule and launch communication cycles at 1012 by editing the content and frequency of any communications that are scheduled to be sent by the program processor." (FIG. 10, reference characters 1010, 1012; page 31, line 2-8).

Without a teaching for multiple independent customers to operate the modified program via the same program processor, and wherein the participant processor and customer processors are remote from said program processor and remote from the storage device, Eggleston cannot anticipate claim 1. Furthermore, since Eggleston discloses installation and operation at the sponsor's own site, Eggleston teaches away from the invention.

For at least these reasons, Appellant submits the cited reference does not teach or suggest each and every element of claim 1. As such, the rejection of claim 1 under 35 U.S.C. § 102(e) should be removed. Additionally, claims 2-7, 15, 39, 52 and 53 depend from claim 1 and are allowable for at least the same reasons as claim 1.

Claim 24

Claim 24 recites a system for allowing multiple customers to each create an individual, modified motivation or recognition program via a customer processor similar to claim 1. Claim 24 recites:

a storage device; and

a program processor ...operative ...:

to electronically provide to each customer access to a browsable catalog of predefined programs stored in the storage device, each program associated with a business challenge; ...

to allow each customer to electronically **select** one of the presented predefined programs stored in the storage device;

to allow each customer to **modify** at least one component of the selected predefined program;

to allow each customer to electronically store the modified program in the storage device for access by such customer; ...

said modified program executed by the program processor.

(Appendix, lines 81-101, Emphasis added).

As explained above with respect to claim 1, without a teaching that each customer can select, modify and operate the modified program via the same program processor, where the participant processor and customer processors are remote from the program processor and remote from the storage device, Eggleston cannot anticipate claim 24.

For at least these reasons, Appellant submits the cited reference does not teach or suggest each and every element of claim 24. As such, the rejection of claim 24 under 35 U.S.C. § 102(e) should be removed. Additionally, claims 53 and 60 depend from claim 24 and are allowable for at least the same reasons as claim 24.

C. Claims 55 and 61

Claim 55 is directed to a method for allowing a first customer and a second customer to create individual modified motivation or recognitions programs by selecting a rules structure of a predefined program where each customer's participants access the modified program stored in a storage device connected to the program processor and executed by the same program processor. Claim 61 is directed to a method for allowing a first customer and a second customer to create individual modified motivation or recognitions programs by selecting a business challenge and a rules structure of a predefined program where each customer's participants access the modified program stored in a storage device connected to the program processor and executed by the program processor.

Appellants submit that claims 55 and 61 are unanticipated by and patentable over Eggleston in that Eggleston fails to disclose or teach multiple programs on the same storage

device in combination with "allowing the first customer and the second customer to each electronically select via their customer processor a rules structure of the selected predefined program, said rules structure defining the manner in which awards are earned by the first and second customer's participants, wherein the first customer's modification is independent of the second customer's modification." (Appendix, claim 55 at lines 137-140, and claim 61 at lines 187-190).

1. Contrary to Examiner's Argument, Eggleston fails to disclose a selectable rules structure in combination with multiple programs on the same storage device and executed by the same program processor.

Claims 55 and 61 recite that the first and second programs are on the same storage device and are executed by the program processor (Appendix, claim 55 at lines 141-144 and 150-159, and claim 61 at lines 191-194 and 200-209). Claims 55 and 61 also recite that each customer selects a rules structure "defining the manner in which awards are earned by the first and second customer's participants." (Appendix, claim 55 at lines 137-140, and claim 61 at lines 187-190). Once again, by the Examiner's own admission in the final Action Eggleston is deficient. The Examiner notes on pages 20-21 of the final Office action:

> However, column 35, line 4 through column 36 line 19 specifically disclose "the programs for a given incentive program are associated with incentive program rules", and that "any other eligibility rules can be entered by the sponsor in defining the eligibility."

However, Eggleston fails to select a rules structure and, in particular to select rules regarding earned rewards in combination with multiple programs on the same storage device and executed by the same program processor. At best, Eggleston teaches that eligibility rules can be modified. The Examiner also cite column 14, line 14 to column 15, line 15 in this regard on page 20 of the final action. However, this section merely teaches that the sponsor may select prizes, not a rules structure defining the manner in which awards are earned.

2. Eggleston *only* illustrates the modification of eligibility rules.

In contrast to Eggleston, independent claims 55 and 61 recite the combination of multiple programs by various sponsors on the same host system and further recite selecting via their

customer processor a rules structure of the selected program. The rules structure defines the manner in which awards are earned by the first and second customer's participants. Further, the first customer's modification is independent of the second customer's modification. Thus, modifying eligibility rules as illustrated Eggleston does not anticipate selecting the rules structure defining how awards are earned, as recited by claims 55 and 61.

Claim 55

    Claim 55 recites:

    A method for allowing multiple customers to each create an individual, modified motivation or recognition program having participants, ..., each said program permitting the participants to access their program via a participant processor and to earn awards through the program in which they participate on the basis of the participants' performance, each said program of a particular customer operating according to preferences selected by the particular customer, said method comprising the steps of:
        …
        allowing the first customer and the second customer to each electronically select one of the predefined programs stored in the storage device via their customer processor, wherein the first customer's selection is independent of the second customer's selection;
        allowing the first customer and the second customer to each electronically select via their customer processor a rules structure of the selected predefined program, said rules structure defining the manner in which awards are earned by the first and second customer's participants, wherein the first customer's modification is independent of the second customer's modification....
        (Appendix, claim 55 at lines 121-127, and 134-140)

    None of the references, taken individually or in combination, discloses or suggests these elements. Without teaching each element, Eggleston cannot anticipate claim 55.

    For example, rules structures define the manner in which awards are earned by the participants and the customer can select the rules structure to reflect the individual needs of the customer. (Specification, page 17, lines 9-12). Sales contests may be based on rules structures such as: Hit and Win, Top Performer, Dollar One, Up To and Over, and Incremental Sales. (Specification, page 17, lines 18-21). In the Hit and Win rules structure, an objective is set and communicated to drive each participant and when the objective is reached, the participant earns the award. (Specification, page 17, lines 21-23). Additional rules structures may be accommodated as appropriate to promote other performance such as participant suggestions, safety, productivity, or presenteeism. (Specification, page 18, lines 11-14).

The Eggleston reference fails to teach or suggest "allowing the first customer and the second customer to each electronically select via their customer processor a rules structure of the selected predefined program" as recited in claim 55. For at least these reasons, Appellant submits the cited reference does not teach or suggest each and every element of claim 55. As such, the rejection of claim 55 under 35 U.S.C. § 102(e) should be removed.

Claim 61

Claim 61 recites a method for allowing multiple customers to each create an individual, modified motivation or recognition program via a customer processor by selecting a rules structure similar to claim 55. Claim 61 recites:

> A method for allowing multiple customers to each create an individual, modified motivation or recognition program having participants, ... each said program permitting the participants to access their program via a participant processor and to earn awards through the program in which they participate on the basis of the participants' performance, each said program of a particular customer operating according to preferences selected by the particular customer, said method comprising the steps of:
> > ...
> > allowing the first customer and the second customer to each electronically select one of the presented predefined programs stored in the storage device via their customer processor, wherein the first customer's selection is independent of the second customer's selection;
> > allowing the first customer and the second customer to each electronically select via their customer processor a rules structure of the selected predefined program, said rules structure defining the manner in which awards are earned by the first and second customer's participants, wherein the first customer's modification is independent of the second customer's modification....
> > (Appendix, claim 61 at lines 168-174, and 184-190)

As explained above with respect to claim 55, without a teaching of the first customer and the second customer to each electronically select via their customer processor a rules structure of the selected predefined program, Eggleston cannot anticipate claim 61.

For at least these reasons, Appellant submits the cited reference does not teach or suggest each and every element of claim 61. As such, the rejection of claim 61 under 35 U.S.C. § 102(e) should be removed.

Rejection under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number: 6,061,660 in view of Hoffman and Rogelberg

Claim 2 depends from claim 1 and is allowable for at least the same reasons as stated above with respect to claim 1.

Rejection under 35 U.S.C. 103(a) 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number. 6,061,660 et al. in view of Symons and Jacobs

Claim 39 depends from claim 1 and is allowable for at least the same reasons as stated above with respect to claim 1.

REMARKS

Appellant submits that the Appeal Brief, as corrected by the Amended Grounds of Rejection and the Amended Argument as submitted herewith, is now in compliance with 37 CFR 41.37(c)(1)(vi) and 37 CFR 41.37(c)(1)(vii). Therefore, Appellant respectfully requests a substantive evaluation of the issues presented.

Respectfully submitted,

/Robert M. Bain/

Robert M. Bain, Reg. No. 36,736 for
Frank Agovino, Reg. No. 27,416
SENNIGER POWERS LLP
One Metropolitan Square, 16th Floor
St. Louis, Missouri 63102
(314) 231-5400